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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/136,954 08/19/98 AZIZ

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EXAMINER

LAUFER, P

ART UNIT

PAPER NUMBER

2766

DATE MAILED:

05/18/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/136,954

Applicant(s)

Aziz et al.

Examiner 703 306 4160

Pinchus M. Laufer

Group Art Unit

2766



☒ Responsive to communication(s) filed on 22 Dec 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-53 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-53 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

### **Part III DETAILED ACTION**

#### ***Objections Related to Reissue Formalities***

1. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

#### ***Claim Rejections - 35 U.S.C. § 251***

2. Claims 26-53 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

In response to the art rejection in the parent case, (paper #10, dated 21 December 1995) Applicant added the following language to claims 6 and 14 respectively:

**Claim 6: (column 18, lines 61-64 of the '646 patent)**

“generating a new address header and appending said new address header to said first data packet, thereby generating a modified first data packet”

**Claim 14: (column 20, lines 21-22 of the '646 patent)**

“generating a new address header for said first data packet”

Furthermore, claims 16 and 17 newly presented as part of the aforementioned response each contained this feature, and Applicant's arguments (page 5) rely on the new header for overcoming the art rejection.

#### ***Claim Objections***

3. Claims 6, 14, and 22-25 are objected to because of the following informalities:

(a) Claim 22 line 8: “second” should be -- first --

(b) Claim 22 line 9: There is a textual problem. Perhaps deleting “portion of” would suffice.

(c) Claim 6 line 20: “a first said data packet” needs correction

(d) Claim 14 lines 20 and 25: "said at least one predetermined criterion" should be -- at least one of said predetermined criteria --

***Claim Rejections - 35 U.S.C. § 101***

4. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

5. Claims 36-37 and 50-51 are rejected under 35 U.S.C. § 101 because they are non-statutory. The claims constitute Non-Functional Descriptive Material, i.e., data on a recording medium. *See Examination Guidelines for Computer Related Inventions 1184 OG 87, 89 (3/26/1996) IV.B.1.(b)* which states:

Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under § 101.

and *See Guidelines, 1184 OG at 90:*

The policy that precludes the patenting of non-functional descriptive material would be easily frustrated if the same descriptive material could be patented when claimed as an article of manufacture.

Note that as claimed there is merely software on a disk. As such, there is no functionality imparted to the system nor does it actuate a device to cause it to carry out any functions.

***Claim Rejections - 35 U.S.C. § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-15, 17-21, 30-33, 36-39, 44-46, and 50-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claims 1, 6, 11, 17, and 18:** The use of the terms "data packet" "first data packet" and "modified data packet" are used in a way which creates logical inconsistencies and confusion as to what the claim is intended to cover.

Claim 1 step (5) "transmitting the data packet" lacks proper antecedent basis;  
Claim 1 step (4) line 2: "first data packet" should probably be "encrypted first data packet"  
Claim 1 step (7): the "encapsulation header" can not be read if step (4) has not been executed

Claim 6, 7 lines from end: "said first data packet" has problems. Depending on whether encryption was performed, this should be "first" or "modified first".

Claim 11 step (5) "transmitting the first data packet" has logical flow problem. If steps 3 and 4 were executed, what exactly is the "first data packet"? The packet before encryption? with the original header? with the modified header?

Claim 11 step (6): the "encapsulation header" can not be read if step (4) has not been executed

Claim 12 line 2: "the modified data packet" lacks antecedent basis.

Claim 14 penultimate line: "said data packet" lacks proper antecedent basis. There are multiple data packets previously referenced.

Claim 17 step (5) "transmitting the data packet" has logical flow problem. If steps 3 and 4 were executed, what exactly is the "data packet"? The packet before encryption? with the original header? with the modified header? the "modified packet"?

Claim 18: "data packet" is used inconsistently in lines 11 and 14

Claim 30 is not clear: (a) "the encrypted data packet data section storing the encrypted data packet" yet "the encrypted data packet includes ... an encrypted data packet data section".?!  
(b) Does "encrypted data packet header section" means that the data packet header section is encrypted or that the encrypted data packet has a header section? Claim 44 has similarly confusing language.

Claims 36, 38, 50, and 53: the phrases "computer code that receives" "... determines" "... encrypts" etc. are all unclear. Perhaps what is meant is "computer code that when executed on a ... causes the processor to determine" etc.

The aforementioned ambiguities render the claims and those depending from them indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention

*For examination over the art, the "transmitted packets" were interpreted to mean the appropriate packet (encrypted or unencrypted) depending on the logic flow. Nevertheless, the claim language must be corrected to eliminate ambiguities.*

***Claim Rejections - 35 U.S.C. § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9. Claims 26, 27, and 29 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Carter et al. ('192). The repeater checks access values (based on source and destination address) and, if access is not allowed, distorts the data before retransmitting.

10. Claims 1, 6, 11, 13-18, 26-29, 34-39, 40-43, and 48-53 are rejected under 35 U.S.C. § 102(e) as being anticipated by Adams Jr. et al. ('708). Adams ('708) teaches a CNEDD (which can be configured as part of a PC, workstation, bridge, router etc.) which examines the header of a packet and consults a table which includes handling instructions for the packet based on source, destination or other information provided in the header. When the handling determines that encryption is called for, the header is modified and then recombined with the data packet to achieve a "modified packet" [6:13-35;7:21-35]. On the receiving end the header is examined to determine whether the data should be decrypted by consulting a table similar to the one at the transmitting side. Claim 1 requires a new header to form a modified packet - this is met by the modified header attached to the encrypted data packet. Note also, the use of data packet in the claims sometimes means the entire packet (header + data; Claim 18 line 11) and elsewhere means the data section without the header. (claim 18, line 14).

11. Claims 1-53 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Adams Jr. et al. ('782). Note that this patent issued on a c-i-p of application 28,437 (March 1993), while the Adams, Jr. ('708) patent issued on a continuation of application 28,437 (March 1993). This application includes a second embodiment referred to as the "tunneling mode" depicted in Figures 7B and 9. Adams ('782) teaches a CNEDD (which can be configured as part of a PC, workstation, bridge, router etc. - see claims) which examines the header of a packet and consults a table which includes handling instructions for the packet based on source, destination or other information provided in the header. When the handling determines that encryption is called for: (a) in the standard mode, the header is modified and then recombined with the data packet to achieve a "modified packet". On the receiving end the header is examined to determine whether the data should be

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decrypted by consulting a table similar to the one at the transmitting side [8:15-9:15 for details]; (b) in "tunneling" mode, the header is also encrypted and an additional header with new routing information is added. [6:63-7:6]. The new header may merely copy the routing information, but [9:57-10:2] it can also replace the source and destination addresses with the CNEDD address and the target network address. The inverse process takes place at the receiving end.

The tunneling mode meets all the claims. In this rejection, the modified header is an additional header which is attached after encrypted the entire data packet (data field + header field). With respect to claims 36-39 and 50-53, Adams is clearly being performed by software control of a system. Therefore, the computer program product and the code itself are inherent.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

***Information Regarding Communication with the PTO***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pinchus M. Laufer whose telephone number is (703) 306-4160. The examiner can normally be reached on weekdays from 7:30 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, G. O. Hayes, can be reached on (703) 305-9711. The fax phone number for this Group is (703) 308-9051.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

May 11, 1999

*Pinchus M. Laufer*  
**Pinchus M. Laufer**  
**Art Unit 2766**